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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/201,749	12/01/1998	PING-WEN ONG	11	1977

7590 03/31/2006

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EXAMINER	
COLBERT, ELLA	
ART UNIT	**PAPER NUMBER**
3624	

DATE MAILED: 03/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/201,749	ONG, PING-WEN	
	Examiner	Art Unit	
	Ella Colbert	3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 January 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-28 are pending. Claims 1, 8, 15, 16, 22, and 28 have been amended in this communication filed 1/20/06 entered as Response After Non-Final Action.

2. The 35 USC 112,second paragraph rejection for claims 1, 8, 15, 16, 22, and 28 still remain for the reason set forth here below.

Claim Rejections - 35 USC § 112

3 The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 8, 15, 16, 22, and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 8, 15, 16, 22, and 28 recite "... identifying as a function of said creation time-stamp and said requested time-stamp ...". It is unclear where Applicants' step is in the claim for the "creation time-stamp". There appears to be a step missing from the claim. The step is the "creation of the time-stamp". The time-stamp has to be created prior to identifying a function of the creation time-stamp. When and how was the time-stamp created?

The recitation "a method for providing an electronic document, said electronic document having multiple versions, each of said versions identified by a creation time-stamp indicating a creation time of the corresponding version" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not

depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-4, 8-11, 15-19, 22-25 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,991,773) Tagawa.

With respect to claim 1, Tagawa teaches the steps of: receiving a request for the electronic document, the request including a requested time-stamp indicating a time associated with a desired version of the electronic document and a requested domain name associated with said time-stamp (col. 2, line 54-col. 3, line 20, receiving a Uniform Resource Locator (URL) including a timestamp indicating a time of creating a version from the terminal via a network (col. 5, lines 32-41 and lines 59-65, col. 6, lines 48-57); identifying as a function of said creation time-stamp and said requested time-stamp a desired version of said electronic document having a creation time corresponding to said requested time-stamp (col. 3, lines 5-20 and lines 25-34); and
identifying an address of said desired version of said the electronic document stored on a server corresponding to the requested timestamp as a function of said requested time-stamp and said requested domain name (col. 5, line 5-col. 6, line 57), wherein a server identified by the requested domain name does not provide said desired version at a time of said request and said identified server has a redirected domain name that is different than said requested domain name (col. 7, lines 31-67, col. 8, lines 35-49, and col. 10, lines 43-52).

With respect to claim 8, Tagawa further teaches, a memory (col. 4, lines 56-62and Figs. 3(a) –3 (b)) and a processor (col. 4, lines 59-63 and lines 65-67 and Figs. 3(a)-3(b)).

Independent claim 8 is a computer system performing the method of claim 1 and is also rejected for the similar rationale as given above for claim 1.

With respect to claim 15, an article of manufacture comprising a computer readable medium having a computer readable program code means embodied thereon performing the method of claim 1, and is rejected under the similar rationale.

With respect to claim 16, a method for resolving a domain name performing the method steps of claim 1 and is also rejected for the similar rationale as given above for claim 1.

With respect to claim 22, Tagawa teaches a memory for storing a database identifying a machine storing an electronic document (col. 1, lines 13-50) and a processor (col. 4, lines 59-63 and lines 65-67 and Figs. 3(a)-3(b)). This claim is rejected for the similar rationale as given above for claims 8 and 16.

With respect to claim 28 is an article of manufacture for resolving a domain name for performing the steps of claim 16 and 22. Tagawa further teaches, identifying a server associated with the said domain name ... (col. 5, line 5 –col. 6, line 57).

With respect to claims 2, 9, 17, and 23, Tagawa teaches, an address identifying the document includes the creation time-stamp (receiving from a user one or more values indicative of one or more selected segments of the streams corresponding to selected intervals of time (col. 2, line 54-col. 3, line 20 and col. 10, lines 47-49 -URL address includes timestamp 950910).

With respect to claims 3,10, 18, and 24, Tagawa teaches, the address is a Uniform Resource Locator ("URL") (col. 2, line 54-col. 3, line 20 and col. 10, lines 47-49, timestamp 950910 is a Uniform Resource Locator ("URL")).

With respect to claims 4, 11, 19, and 25, Tagawa teaches, the Uniform Resource Locator ("URL") has an associated request header for indicating said requested time stamp (col. 7, lines 10-50 and Fig. 10).

7. Claims 5-7, 12-14, 20, 21, 26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,991,773) Tagawa in view of Freeman et al (US 6,006,227), hereafter

With respect to claims 5 and 13, Tagawa failed to teach, transmitting the version of said electronic document with the most recent creation time-stamp preceding the requested time-stamp if a version of the electronic document does not exist with the requested time-stamp (setting the time to the future or past is to reset the time-cursor temporary to a fixed position designated by the user. Freeman teaches, transmitting the version of said electronic document with the most recent creation time-stamp preceding the requested time-stamp if a version of the electronic document does not exist with the requested time-stamp (setting the time to the future or past is to reset the time-cursor temporary to a fixed position designated by the user (col. 7, line 49- col. 67, line 10). It would have been obvious to one having ordinary skill in the art at the time the invention was made to transmit the version of said electronic document with the most recent creation time-stamp preceding the requested time-stamp if a version of the electronic document does not exist with the requested time-stamp (setting the time to the future or

past is to reset the time-cursor temporary to a fixed position designated by the user and to modify in Tagawa because such a modification would allow Tagawa to be transmitted by server running over the Internet handling one or more documents.

With respect to claims 6, 12, 20, and 26, Tagawa failed to teach, the request is specified using a browser. Freeman teaches, the request is specified using a browser (copying a Web address from a Web browser; col. 13, lines 27-45). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the request specified using a browser and to modify in Tagawa because such a modification would allow Tagawa to have the capability to copy a Web address from a web browser to document (specifying using a browser).

With respect to claims 7, 14, 21, and 27, Tagawa failed to teach, the requested time-stamp is a relative time-stamp (chronological indicators including past, present, and future times. Freeman teaches, the requested time-stamp is a relative time-stamp (chronological indicators including past, present, and future times (col. 13, lines 30-35). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the requested time-stamp is a relative time-stamp and to modify in Tagawa because such a modification would allow Tagawa to have chronological indicators including past, present, and future times as expressed by Freeman in col. 2, line 62-col. 3, line 29).

Response to Arguments

8. Applicant's arguments filed 1/20/06 have been fully considered but they are not persuasive.

Issue no. 1: Applicants' argue: Claim 1 is directed to a method for providing an electronic document and refers to both a creation time-stamp and a requested time stamp. The versions of the electronic document are identified by a creation time-stamp, which is created prior to the utilization of the method for providing the electronic document. In other words, an electronic document having a creation time-stamp is assumed to exist prior to the execution of the methods defined in claims 1, 16, 22, and 28 has been considered but is not persuasive. Response: It is respectfully submitted that if the electronic document having a creation time-stamp is assumed to exist prior to the execution of the methods as defined in claims 1, 16, 22, and 28 why isn't the method for an electronic document creation of a time-stamp a method step in the claim limitations? One cannot leave something to an assumption that it merely exists.

Conclusion: In this rejection of claim 1 and others, for example under Section 103 (a) of Title 35 of the United States Code, the Examiner carefully drew up a correspondence between the Applicants' claimed limitations and one or more referenced passages in the Tagawa and Freeman references, what is well known in the art, and what is known to one having ordinary skill in the art (the skilled artisan). The Examiner is entitled to give claim limitations their broadest reasonable interpretation in light of the Specification (see below):

2111 Claim Interpretation; Broadest Reasonable Interpretation [R-1]

>CLAIMS MUST BE GIVEN THEIR BROADEST REASONABLE INTERPRETATION
During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification." Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the

examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969).<

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

There are outstanding 35 U.S.C. 112, second paragraph issues with the claims as addressed above which need clarification in the claim language and Applicants' need to particularly point out and to claim the novel feature of their invention in the independent claims. Where is this feature claimed in claims 1, 8, 15, 16, 22, and 28?

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Inquiries

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Tuesday-Thursday, 6:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

E. Colbert
Primary Examiner
March 29, 2006